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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,370	12/20/2001	Robert Uyeki	23484-031	9654

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/027,370

Applicant(s)

UYEKI, ROBERT

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-20 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-20, 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's amendment of 12/29/04 has been entered. The examiner will address applicant's remarks at the end of this office action. Currently claims 1-5,7-20,22-28 are pending.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5,7-20,22-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed did not disclose the limitation of "wherein the vehicle monitoring means includes no hardware at the parking area". This is considered new matter. The specification as originally filed discloses that in one embodiment the vehicle monitoring means is data that is entered into the terminal at the parking area, and this would require some hardware at the parking area, namely the terminal. Having "no hardware" is new matter. Also, don't you at least need a GPS unit in the vehicle, and if the vehicle is at the parking area this would constitute hardware at the parking area? Having a function performed with no hardware is not possible. The examiner also takes notice that applicant did not state for the examiner where support can be found in the specification as originally filed for the newly added claim language. Upon a review of the specification none can be found.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9,19, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 9, applicant has claimed that the vehicle monitoring means is user input information. User input information is simply data. Data alone is not capable of monitoring a vehicle so the examiner is not clear as to what is being claimed here. Correction is required. Also, this claim contradicts claim 1 that requires the vehicle monitoring means to be "geo fencing means". It is not clear as to what the vehicle monitoring means is? Is it geo-fencing means or is it data?

For claim 19, this claim contradicts claim 18 that requires the vehicle monitoring means to be "geo fencing means". It is not clear as to what the vehicle monitoring means is? Is it geo-fencing means or is it user input information?

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5,7-20,22-28, are rejected under 35 U.S.C. 102(b) as being anticipated by Klein et al. (5726885).

For claims 1-4,8,18, Klein discloses a vehicle renting system. Klein discloses a terminal (HA or the card reader of each car), register means and central computer (D), vehicle monitoring means (col. 6, lines 1-12), parking area (H1), communication means (1), and information device (either part of HA or 1). With respect to the newly added limitation of the vehicle monitoring means being "geo-fencing means", as this is best understood by the examiner this is a recitation to a GPS system, which is disclosed by Klein. The instant specification discloses the fact that "geo-fencing" is a GPS system. The GPS system of Klein monitors the use of the vehicle and monitors the location of the vehicles so that they can be tracked and accounted for as claimed. The recited functions for both the "vehicle monitoring means" and the "geo-fencing means" are present in the GPS system of Klein and satisfy what is claimed. Additionally, geo-fencing is utilization of a GPS system for vehicle tracking so reciting "geo-fencing" is still just a recitation to a GPS system for the monitoring of the vehicles. Claim 2 also reinforces this position taken by the examiner because claim 2 is reciting a GPS system (exactly what Klein discloses).

For claims 5,14, applicant is reciting a method limitation and this has been considered to the extent that the prior art must be capable of doing what is claimed. Klein is fully capable of operating as claimed. Intended use limitations in article claims will be given minimal patentable weight.

For claims 7,20, the examiner feels that they read on a GPS device that is disclosed by Klein. A GPS device provides the ability to monitor the entry and exiting of vehicles from the parking lot. A GPS unit is the device that is used to allow the function of the means plus function language to occur. "Geo-fencing" is and requires a GPS unit.

For claims 9-13,19, applicant has recited data and nothing more. This is considered to be non-functional descriptive material and because Klein uses input data, Klein anticipates this claim. The kind of data being used is non-functional descriptive material.

For claims 15,16,17, the card reader of Klein is vehicle mounted and reads information from an identification card as claimed. The kind of data being used is non-functional descriptive material.

For newly added method claims 22-28, Kline discloses the providing of a parking area for a user to obtain a vehicle from. The providing "geo-fencing means" is satisfied by the GPS system that Klein uses to track and monitor the vehicles with. Geo-fencing is and requires a GPS unit. Kline discloses that users can request the use of a vehicle at terminal HA, where the terminal accepts user input information, and can determine whether or not a vehicle is available for the user based on entered information (what vehicle is desired, how long, and is the vehicle presently being used or is it even available). The availability is communicated to the user as claimed.

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7. Applicant's arguments filed 12/29/04 have been fully considered but they are not persuasive.

With respect to the traversal of the 112 rejection for claim 9, the argument is non-persuasive. Data is just data and is not capable of doing anything, especially monitoring the usage of the vehicles. Applicant has stated:

"This user-input information may include the user's intended destination and/or duration of use. This allows the central computer to monitor when the vehicle would be due to return and be available for reallocation."

Applicants own statement is in agreement that the data is not doing the monitoring, which is what has been claimed.

With respect to Klein not disclosing a geo-fencing means and not disclosing the claimed vehicle availability determination, the examiner disagrees. Geo fencing is determining location by using a GPS unit. Klein discloses a GPS unit for determining vehicle location. Klein discloses what is claimed. Concerning the vehicle availability determination, Klein uses the data concerning the user's desired vehicle and usage data (duration, time, etc.) to indicate whether or not the request can be satisfied. If the vehicle is currently being used or was being used and is not returned yet, this is also taken into account when determining vehicle availability. The arguments are non-persuasive.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER